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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/512,223	02/24/2000	Martin Miehling	104142	5686

7590 01/31/2002

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EXAMINER
DINH, TUAN T

ART UNIT	PAPER NUMBER
2827	

DATE MAILED: 01/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/512,223	MIEHLING, MARTIN	
	Examiner	Art Unit	
	Tuan T Dinh	2827	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 November 2001* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) *16-28* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claims 16-28 are withdrawn from further consideration as being drawn to non-selected subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoppe et al. (Reference cited by applicant).

As to claim 1, Hoppe discloses an electrical circuit (1-figure 1, column 3, line 16) as shown in figures 1-5 comprising:

an integrated circuit (3-figure 2b, column 3, line 18),

an antenna (17-figure 2b, column 4, line 20),

one or more electrical connections (25-figure 2b, column 4, lines 24-25) between the integrated circuit (3) and the antenna (17), and

wherein at least the integrated circuit and the antenna are encapsulated within a capsule (15, column 3, lines 30-36, 58-64, column 4, lines 18-24) such that the capsule (15) mechanically connects the integrated circuit (3) and the antenna (17) the hold the integrated circuit and antenna in a fixed position relative to each other.

Hoppe does not teach a capsule comprises a thermoplastic resin having a melting point of from 120°C to 250°C.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a thermoplastic resin having a melting point of from 120°C to 250°C to modify the electrical circuit of Hoppe in order to seal and protect a chip within the electrical circuit

As to claim 2, Hoppe discloses an electrical circuit as shown in figure 5 wherein the capsule (15) completely encapsulates the electrical circuit (see figure 5b).

As to claim 3, Hoppe discloses an electrical circuit as shown in figure 5 wherein the capsule (15) encapsulates the electrical circuit only on one surface of the electrical circuit (see figure 5b).

As to claim 4, Hoppe discloses an electrical circuit as shown in figures 1-5 wherein the electrical circuit is encapsulated within the capsule (15) such that at least one or more electrical connections are encapsulated by the thermoplastic resin (see figure 5b).

As to claim 5, Hoppe discloses an electrical circuit as shown in figures 1-5 wherein the antenna is a coil (17, column 4, line 20).

As to claim 6, Hoppe discloses a data carrier capable of being a transponder as shown in figures 1-5 comprising:

an electrical circuit (1) containing at least one component (3) suitable for interaction with an electromagnetic field (coil 17) encapsulated within a capsule (15),

and wherein the electrical circuit is encapsulated by the thermoplastic resin such that at least an integrated circuit (3) and an antenna (17) of the electrical circuit are encapsulated by the thermoplastic resin.

Hoppe does not teach a capsule comprises a thermoplastic resin having a melting point of from 120°C to 250°C.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a thermoplastic resin having a melting point of from 120°C to 250°C to modify the electrical circuit of Hoppe in order to seal and protect a chip within the electrical circuit

As to claims 7 and 10, Hoppe does not teach a transponder as shown in figures 1-5 wherein the thermoplastic resin consists essentially of thermoplastic polyamide or PCV. However, It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a thermoplastic polyamide or PCV to modify the transponder of Hoppe in order to have good insulation and seal when a component of the transponder operated, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

As to claims 8-9, Hoppe discloses a transponder as shown in figures 1-5 wherein at least part of a surface of the capsule is covered with a cover layer of laminated film, said laminated film comprises a plastic (35, 37, column 5, line 23).

As to claim 11, Hoppe discloses a transponder as shown in figures 1-5 wherein the antenna is a coil (17).

As to claim 12, Hoppe discloses a transponder as shown in figures 1-5 wherein the electrical circuit (1) further comprises one or more electrical connections (25)

connecting the integrated circuit (3) in electrically conducting fashion with the antenna (17-see figure 5b).

As to claim 13, Hoppe discloses a transponder as shown in figures 1-5 wherein the capsule (15) further comprises at least one supporting element (37) projecting from surface of integrated circuit (3).

As to claim 14, Hoppe discloses a transponder as shown in figures 1-5 wherein the capsule (15) includes a material used as a mold during encapsulation with the thermoplastic resin (column 3, lines 30-31).

As to claim 15, Hoppe discloses a transponder as shown in figures 1-5 wherein the transponder further comprises a sheath (35; 37) of injection-molded resin surrounding the encapsulated electrical circuit.

Response to Arguments

Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Brady et al. and Aflenzer et al. disclose related art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan T Dinh whose telephone number is 703-306-5856. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Talbott can be reached on 703-305-9883. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-1341 for regular communications and 703-308-3431 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-9560.

TD
January 23, 2002

Primary Examiner